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EXAMINER

GARCIA, ERNESTO

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/613,605	Applicant(s) DEROGATIS ET AL.	
	Examiner Ernesto Garcia	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007 and 25 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-71 and 73-81 is/are rejected.
- 7) ☒ Claim(s) 72 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The indicated allowability of claim 65 is withdrawn in view of the newly discovered reference to Barton, 2,363,477. Rejections based on the newly cited reference follow. Further, the amendment to claim 71 introduces a new 35 U.S.C. 112, second paragraph rejection. Prosecution is hereby reopened based on the new reference.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

The drawings were received on June 25, 2007. The drawings are not acceptable since the record has a few discrepancies on the labeling of the sheets. In particular, the sheet filed on July 5, 2006 has been incorrectly label as "replacement sheet" when in fact the original drawings filed on July 3, 2003 never contained this sheet. The examiner is requesting all the drawing sheets submitted as one packet so that the record is clear relative to the original drawings filed on July 3, 2003. Therefore, applicant needs to replace sheets 1-8 of July 3, 2003 and labeled as "Replacement Sheets". Any new sheet, added thereafter, should be labeled "New Sheet" so that the record is clear relative to the original drawings of July 3, 2003. Applicant is reminded

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that the same figures of the original sheets must be presented in the corresponding sheets to be considered a "replacement sheet". Note that shifting figures around in a sheet, as in the later filed sheets from the original drawings, is not considered a replacement sheet.

It should be noted that the following drawings objections are made relative to the drawings filed on June 25, 2007.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the opening 216A being rectangular as described on paragraph [0058] of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "211A" (Figure 15A) and "211B" (Figure 15B) have both been used to designate the same upper ridges.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "213A" (Figure 15A) and "213B" (Figure 15B) have both been used to designate the same lower ridges.

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The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "222A₁" (Figure 15A) and "222B₁" (Figure 15B) have both been used to designate the same upper centered ridge.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "222A₂" (Figure 15A) and "222B₂" (Figure 15B) have both been used to designate the same lower centered ridge.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The amendments filed February 23, 2007, October 25, 2006, and September 2, 2005 are objected to under 35 U.S.C. 132(a) because they introduce new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows:

Amended paragraph [0058] filed on October 25, 2006 introduces the term "optionally". This term is not supported by the specification and the original disclosure clearly stated "preferably being sized and shaped to accommodate standard-sized tools". Further, the term "optionally" as now used is different and conveys a different approach than been preferably as originally disclosed.

The amended Figures 15, 15A, and 15c filed on February 23, 2007 contain new matter. This error has now come to the examiner attention and needs to be addressed since the examiner has noticed a discrepancy between the original sheets. The original filed Figure 15 showed the aperture being rectangular such that an Allen wrench can be inserted in the opening (see original paragraph 058) to provide torque. The new opening goes through the plug fastener and is cylindrical all the way through. The original specification never mentions that the rectangular opening 216 goes through the plug faster to both ends. According to the original paragraph 058, the specification

mentions that the fastener is provided with an aperture 216 on at least one end thereof to accommodate standard-sized tools such as those of rectangular cross-section or other cross-section, e.g. hexagonal, to apply torque. Therefore, at most, a square or rectangular opening is provided in at least one end of the plug fastener without the square or rectangular aperture connecting to the other aperture at the other end. Applicant should note that the original filed specification established the aperture 216 being square and not cylindrical.

Further, the amendment filed on September 2, 2005 introduces new matter in paragraph [0057]. The original disclosure defined the stop 222 provided on the exterior surface of the fasteners between the first portion and the second portion as shown in the original filed drawings. The new matter introduces more than one stop "in either or both the portions" when in fact the stop was located in between the two portions. Further, the original disclosure or the original drawings never established that the stop 222 is simply the ridges having the outermost diameters. Further, the description that the outermost ridges "do not function strictly as a positive stop" is new and not supported by the original filed drawings.

Applicant is required to cancel the new matter in the reply to this Office Action.

The disclosure is objected to because of the following informalities: the description of the reference characters 222A₁-222B₂ in paragraph [0057] is inconsistent.

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In one instance, they are described as stops and later described as outermost ridges. Further, the function of these outermost ridges is unclear since they have been described as stops yet the same ridges "do not function strictly as a positive stop" as described on the same paragraph. Are the ridges 222A₁-222B₂ stops or not? Wasn't there just one stop between the hemispherical portions according to the original specification? The stops 222A₁-222B₂ do not appear in between but rather each is respectively located in the hemispherical portions. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "the ridges on the first hemispheroidal portion are directed towards the ridges on the second hemispheroidal portion" recited in claim 73, lines 1-3.

Claim Objections

Claim 65 is objected to because of the following informalities:

regarding claim 65, "symmetry" in line 11 should be --opposition--. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

Claim 71 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 71, the metes and bound of the claim is still unclear. In particular, claim 67 inferentially makes reference to a railing, which is not part of the claimed plug fastener. However, claim 71 makes reference to the same railing as being part of the plug fastener, i.e., "affixing the plug fastener to the railing" with the elongate fastener. Note that the language "adapted to be affixed to a flat surface of a railing" in claim 67 does not imply that the railing is claimed. Therefore, it is unclear whether the railing is part of the claimed plug fastener or merely intended to be used with the railing. For purposes of this Office action, the examiner has considered the plug faster without the railing.

Claim Rejections - 35 USC § 102

Claims 65, 67, 68, 70, 71, 75, and 77-81 are rejected under 35 U.S.C. 102(b) as being anticipated by Barton, 2,363,477.

Regarding claim 65, Barton discloses, in Figures 1 and 2, a plug fastener comprising a first hemispheroidal portion A1 (see marked-up attachment) and a second hemispheroidal portion A2 opposed to the first hemispheroidal portion A1. The first

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hemispheroidal portion A1 is symmetrical to the second hemispheroidal portion A2 about their plane of opposition A3. Each hemispheroidal portion A1,A2 comprises a mating surface A4 respectively truncating the hemispheroidal portions A1,A2. The mating surface A4 defines a mating plane A5 parallel to the plane of opposition A3. The mating planes A5 of the first and second hemispheroidal portions A1,A2 are opposite from each other across the plane of opposition A3. Ridges 19-24 extend outwardly from the respective hemispheroidal portions between the mating surfaces A4 and the plane of opposition A3. An aperture A6 is defined within and extending through the first and second hemispheroidal portions A1,A2. The aperture A6 has a first countersink A8 (note that Figure 1 show this countersink which allows ease of insertion of a fastener 8) defined within an opening A7 in the first mating surface A4 and a second countersink A6 defined within an opening A7 in the second mating surface A4.

Regarding claim 67, one of the mating surfaces A4 can be adapted to be affixed to a flat surface of a railing.

Regarding claim 68, the plug fastener can be adapted to be affixed to be affixed to be received within a baluster to be attached to the railing.

Regarding claim 70, the plug fastener can be adapted to be hidden from view after the baluster is attached to the railing.

Regarding claim 71, the plug fastener further comprises an elongate fastener **8** disposed in the aperture **A6**.

Regarding claim 75, the ridges **19,20** on the first hemispheroidal portion **A1** are directed towards the ridges **23,24** on the second hemispheroidal portion **A2**.

Regarding claim 77, the ridges **19-24** outwardly extend from corresponding exterior surfaces **A9** of the hemispheroidal portions.

Regarding claim 78, the ridges **19-24** outwardly extend from the exterior surfaces of the hemispheroidal portions define a substantially spherical shape.

Regarding claim 79, the first and second hemispheroidal portions define a substantially spherical shape.

Regarding claim 80, the aperture **A6** is substantially cylindrical between the countersinks **A8**.

Regarding claim 81, the aperture **A6** is substantially perpendicular with respect to the pane of opposition **A3**.

Claim Rejections - 35 USC § 103

Claims 66, 69, and 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton, 2,363,477.

Regarding claim 66, Barton, as discussed, fails to disclose the ridges being deformable ridges. Applicants are reminded that one skilled in the art of sealing will eventually use heat resistant plastic or rubber to provide a sealing effect instead of Niresist as disclosed in column 2, lines 50-55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the plug fastener of heat resistant plastic or rubber thus making the plug fastener deformable overall. Given the modification the ridges will be able to deform.

Regarding claim 69, Barton, as discussed, fails to disclose the ridges being deformable ridges and the ridges having sufficient resiliency. Applicants are reminded that one skilled in the art of sealing will eventually use heat resistant plastic or rubber to provide a sealing effect instead of Niresist as disclosed in column 2, lines 50-55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the plug fastener of heat resistant plastic or rubber thus making the plug fastener deformable overall. Given the modification the ridges will be able to deform and have sufficient resiliency.

Regarding claim 74, Barton, as discussed, fails to disclose the ridges having a substantially triangular shape. Applicants are reminded that changing the shape of the ridges is an obvious modification to provide the same sealing effect. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the ridges substantially triangular to provide the same sealing effect used in labyrinth seals.

Regarding claim 75, Barton, as discussed, fails to disclose the plug fastener being non-metallic. Applicants are reminded that one skilled in the art of sealing will eventually use heat resistant plastic or rubber to provide a sealing effect instead of Niresist as disclosed in column 2, lines 50-55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the plug fastener of heat resistant plastic or rubber to provide a better sealing effect than metal.

Regarding claim 76, given the modification of claim 75, one skilled in the art will choice from a material being plastic to provide a better seal.

Allowable Subject Matter

Claim 72 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 72, the prior art of record does not disclose or suggest a plug fastener further comprising an elongate fastener, disposed in an aperture of the plug fastener (claim 71, lines 1-2), being a screw (claim 72, lines 1-2). Barton, 2,363,477, discloses the plug fastener with a an elongated fastener 8; however, the elongated fastener is a tube.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

E.G.

July 13, 2007

Attachment: one marked-up page of Barton 2,363,477

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large, looped initial 'D'.

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3300

Barton, 2,363,477

